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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,952	09/22/2000	A. Ira Horden	042390.P3275	2770

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EXAMINER

AUVE, GLENN ALLEN

ART UNIT PAPER NUMBER

2111

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/668,952

Applicant(s)

HORDEN ET AL.

Examiner

Glenn A. Auve

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-13 and 62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-13 and 62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Reissue Applications

1. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The reissue declaration is improper because it must refer to all of the amendments made in the application since it was filed. The most recent declaration appears to be the one filed in February 2002, and therefore it does not refer to the subsequent amendments to the claims. Since the claims are not the same as those which were filed at the time of the signing of the declaration, a new declaration/oath is required before the claims could be allowed. See 37 CFR §1.175.

2. Claims 1-8,10-13 and 62 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Recapture

3. Claims 7,8,10-13 and 62 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the

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reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The test for determining whether recapture exists in a reissue application is a three step test set forth by the Court of Appeals for the Federal Circuit in *In re Clement*, 131 F.3d at 1464, 45 USPQ2d 1161 (Fed. Cir 1997) and restated in *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001). This test was slightly modified by the Board of Patent Appeals and Interferences in *Ex parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003). See MPEP §1412.02 for a complete analysis of the applicable test for recapture. The three steps in the *Pannu* test are: 1) Was there broadening? 2) Does any broadening aspect of the reissue claim relate to surrendered subject matter? and 3) Were the reissue claims materially narrowed in other respects to compensate for the broadening in the area of surrender, and thus avoid the recapture rule?

With respect to the first step, applicant admits that this is a broadening reissue in the reissue declaration. As noted in the previous Office Action in paragraph 3, the newly added claims omit many limitations which are present in the patent claims. Therefore there is clearly broadening present and the first step of the test is affirmatively answered.

The second step requires a determination of whether the broadening aspect of the reissue claims relates to surrendered subject matter. In the prosecution of the original application (08/599,648), applicant canceled claims 1,3-7,9-11, and 15 in response to the Final Rejection (After Final Amendment and Response filed February 2, 1998, paper no. 5). In

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applicant's remarks in that paper it is noted that claim 8 was amended to include the limitations of claim 11 (which the examiner had indicated as allowable) along with the limitations of all intervening claims (i.e. claims 9 and 10). Claim 14 was amended to include the limitations of claim 15 which the examiner had also indicated as being allowable. Claim 16 was amended to place it into independent form including the limitations from claim 14 from which it depended, as the examiner had also indicated that claim 16 would be allowable if rewritten in independent form including all the limitations of the base claim. These amendments were all made in response to the examiner's prior art rejection of claims 1,3-10, and 12-14 (claim 2 had already been canceled with its limitations incorporated into claim 1 by amendment). As noted in the previous Office Action, the currently pending new reissue claims omit the limitations relied upon to overcome the prior art rejection in the patent. Therefore the broadening aspect of the reissue claims relates to the surrendered subject matter in that the reissue claims omit the limitations relied upon to overcome the prior art rejection and the second step of the analysis is also answered affirmatively.

Progressing on to the third step of the test (Were the reissue claims materially narrowed in other respects to compensate for the broadening in the area of surrender, and thus avoid the recapture rule?), the claims will be analyzed individually. When analyzing a reissue claim for the possibility of impermissible recapture, there are two different types of analysis that must be performed. If the reissue claim "fails" **either** analysis, recapture exists.

First, the reissue claim must be compared to any claims canceled or amended during prosecution of the original application. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original

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prosecution to define over the art. Claim scope that was canceled or amended is deemed surrendered and therefore barred from reissue. *In re Clement, supra*.

Second, it must be determined whether the reissue claim entirely omits any limitation that was added/argued during the original prosecution to overcome an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture. *Pannu v. Storz Instruments Inc., supra*. However, if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine. *Ex Parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003) (precedential). For example, if the key limitation added to overcome an art rejection was "an orange peel," and the reissue claim instead recites "a citrus fruit peel", the reissue claim may not be rejected on recapture grounds.

Reissue claim 7 is similar to original claim 10 of the parent but it omits the clock signal generator limitation of claim 10. Claim 10 was subject to a prior art rejection and applicant responded by incorporating together all of the limitations of claims 8-11. Therefore with respect to the first part of the analysis set forth above, claim 7 is broader in scope than the original claims which were canceled/amended to define over the prior art. Since claim 7 "fails" this part of the analysis, impermissible recapture exists. Even though it is not necessary to progress to the second part of the analysis, it is also noted that claim 7 entirely omits the limitation added in order to overcome the prior art rejection, i.e. the limitations of claim 11 added to claims 8-10 in the original application. There do not appear to be any limitations in claim 7 which make it narrower in any other aspect, and therefore this part of the analysis also leads to the conclusion that impermissible recapture exists. None of the dependent claims 8,10, and 11 include the

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limitations added to overcome the prior art rejection either, and therefore impermissible recapture also exists with regard to them.

Reissue claim 12 is similar to original claim 14 in the parent except it omits the step of "dynamically changing the required frequency and the minimum supported voltage supplied responsive to a change in the current application mix." Therefore with regard to the first part of the analysis, claim 12 is broader in scope than the original claims which were canceled/amended to define over the prior art. Since claim 12 "fails" this part of the analysis, impermissible recapture exists. Claim 13 basically includes the omitted limitation noted above for claim 12, however, since this would make claim 13 at best of the same scope as the original claims which were canceled/amended to define over the prior art, impermissible recapture also exists with regard to claim 13. Even though it is not necessary to progress to the second part of the analysis, it is also noted that claims 12 and 13 also entirely omit the limitations added in order to overcome the prior art rejection, i.e. the limitations of claim 15 which were added to claim 14 in the original application. There do not appear to be any limitations in claims 12 and 13 which make them narrower in any other aspect, and therefore this part of the analysis also leads to the conclusion that impermissible recapture exists.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beard (5,627,412) in view of what was well known in the art.

a. As per claim 12, Beard teaches a dynamically switchable power supply for an electronic system based upon fluctuating demand for operational power (Abstract). Beard teaches determining a frequency at which the CPU can operate based upon the an applications demand; determines a voltage potential level corresponding to the frequency; and provides the frequency and voltage potential levels to the CPU (Fig. 1; col. 3, line 25 through col. 4, line 23). However, Beard does not explicitly teach a state machine for controlling the voltages. Official notice is taken in that both the concept and advantages of a state machine (controller) for controlling voltages are well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a state machine for controlling voltages in the system of Beard to perform the voltage control tasks outside the CPU to lessen the load of the CPU and save power required by the CPU for operation.

b. As per claim 13, Beard discloses the claimed invention as described above and furthermore, Beard teaches changing the frequency and voltage level in response to a change in the application mix (col. 4, lines 1-23).

Response to Arguments

6. Applicant's arguments filed 8 March 2006 have been fully considered but they are not persuasive.

7. Regarding the defective reissue oath/declaration, applicant argues that the claims have been restored to the way they were submitted with the preliminary amendment and that the oath filed 22 September 2000 covers the claims. However, the claims are not the same as they were

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when they were filed on 22 September 2000. Since the claims have been changed/amended since their initial filing, a new supplemental oath is necessary to cover the changes that have been made to the claims. Therefore applicant's arguments regarding the oath are not persuasive.

8. With regard to the recapture rejection under 35 USC §251, applicant has not provided any arguments beyond a statement that, "It is Applicants' belief that the broadening aspect of the claim language in claims 7,8,10-13, and 62 relates to subject matter that has not been surrendered during prosecution of the application. It is believed that the claims include limitation relied upon to overcome the prior art rejection in the patent." However, such a statement without any supporting argument or attempt to point out evidence to support applicants' "belief" is not at all persuasive.

9. With respect to the prior art rejections, the rejection of claims 7,8,10,11, and 62 based on Beard are withdrawn in light of the amendments to the claims.

10. Regarding the rejection of claims 12 and 13 under 35 USC§102(b), it is noted that these arguments are moot in view of the fact that the claims are now rejected under section 103(a) in light of the amendments to the claims. To the extent that applicant's arguments would be applicable to the new rejection, it is noted that applicant is arguing limitations that are not present in the claims. Applicant argues that Beard teaches that the power level may be selected by the user or, alternatively, monitored by fuzzy logic and that applicant's system does not use fuzzy logic. However, it is noted that Beard shows that the user selection or fuzzy logic are alternative to the operation of the system that was previously described in columns 3-4 of the reference. It is submitted that Beard shows the elements recited in claim 12, except for the state machine limitation as noted in the rejection above. Applicant's argument regarding this point is therefore not persuasive.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

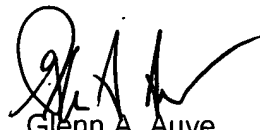
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn A. Auve whose telephone number is (571) 272-3623. The examiner can normally be reached on M-F 8:00 AM-5:30 PM, every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (571) 272-3632. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Glenn A. Auve
Primary Examiner
Art Unit 2111

gaa
17 April 2006